



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,113	02/28/2000	Frank B. Dean	MSI 100	9257
23859	7590	10/31/2003	EXAMINER	
NEEDLE & ROSENBERG, P.C. SUITE 1000 999 PEACHTREE STREET ATLANTA, GA 30309-3915			SISSON, BRADLEY L	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	Application No. 09/514,113	Applicant(s) DEAN ET AL.	
	Examiner Bradley L. Sisson	Art Unit 1634	

--Th MAILING DATE of this communication app ars on th cover sheet with the c rrespondence address --

THE REPLY FILED 20 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-19,21-23,27,31-45 and 77-80

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☒ Other: PTO-892

*B. L. Sisson*

Bradley L. Sisson  
Primary Examiner  
Art Unit: 1634

Continuation of 5. does NOT place the application in condition for allowance because: At page 2 of the response received 20 October 2003, hereinafter the response, applicant asserts that the rejection of claims 1-19, 21-23, 27, 31-45, and 77-80 under both 35 USC 112, second paragraph, and 101 is improper as the claims recite positive method steps. Argument is also advanced that inclusion of "using" in the claim's language is appropriate, citing MPEP 2173.05(q), directing attention to the decision of Ex parte Porter.

The above-argument has been fully considered and has not been found persuasive towards the withdrawal of the rejection. While agreement is reached in that the claim does recite positive method steps, the claim does not recite any method steps as to how the particular "template-deficient oligonucleotide primer" is to be --used-- in the amplification reaction method. Such use is critical to the claimed invention. While applicant asserts at page 2, last paragraph, of their response, that those of skill in the art would know how to use the recited template-deficient primers, it is noted that the rejection has not been made under enablement clause of 35 USC 112, first paragraph, but under 35 USC 112, second paragraph, that deals with defining the metes and bounds of the claim.

In so far as MPEP 2173.05(q) teaching that such language is acceptable, it is noted that the MPEP cites decisions that show there is uncertainty as to whether the claims should be rejected under 35 USC 112, second paragraph, and/or under 35 USC 101. The decision of Ex parte Porter does not resolve this issue. Accordingly, the rejection is maintained.

At pages 4-6 argument is advanced that US Patent 6,027,923 (Wallace) does not teach all of the limitations of the claimed invention, directing attention to the alleged deficiency in teaching "that property (C) is a property of sub-region (B) alone, not of the template-deficient oligonucleotide as a whole."

The above argument has been fully considered and has not been found persuasive. The claims do not contain language that places such special emphasis on the subsection. Additionally, there is no evidence of record that would refute the capability of said subsection (B) from exhibiting property (C). In support of this position, attention is directed to the publication of Sommer and Tautz, which show that efficient priming can take place with two 3' nucleotides annealing to the template where a mismatch (template-deficient region) occurs immediately upstream. By contrast, the disclosure of Wallace teaches that they had three complementary nucleotides at the 3' terminus of their template-deficient oligonucleotide primer. Accordingly, the (B) region of the template-deficient primer of Wallace is considered to exhibit or retain property (C).

The rejection of claims under 102/103 as being either anticipated or rendered obvious by the teachings of Van Ness (US Patent 6,361,940) is hereby withdrawn upon consideration of applicant's arguments found at pages 6-8 of the response.